

SECOND AMENDED APPEAL BRIEF TO THE BOARD OF PATENT APPEALS AND
INTERFERENCES

Application No. : 10/707,437
Applicant : David Liang Mabbutt
Filed : 14 December 2003
Title of Invention : IMPROVED MOUSE PAD
Examiner : Gwendolyn Baxter
Docket No. : DMABB05F
Customer No. : 33310

Board of Patent Appeals and Interferences

U.S. Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

A. REAL PARTY IN INTEREST

David Liang Mabbutt, sole inventor and sole applicant, represented by Edwin A. Skoch,
registered patent attorney.

B. RELATED APPEALS AND INTERFERENCES

None.

C. STATUS OF CLAIMS

Claims 1 through 14 were twice rejected by Examiner Gwendolyn Baxter, first by Office Action dated September 23, 2004, and second by Office Action, dated March 9, 2005. A full listing of the claims on appeal is provided in the Claims Appendix.

The following is a statement of the status of each claim, by number, showing which were rejected (CLAIMS 1 through 14), and identifying the appealed claims (CLAIMS 1 through 10, and 13 and 14), and pointing out the claims which are not on appeal (CLAIMS 11 and 12).

CLAIM 1. [REJECTED & ON APPEAL]

CLAIM 2. [REJECTED & ON APPEAL]

CLAIM 3. [REJECTED & ON APPEAL]

CLAIM 4. [REJECTED & ON APPEAL]

CLAIM 5. [REJECTED & ON APPEAL]

CLAIM 6. [REJECTED & ON APPEAL]

CLAIM 7. [REJECTED & ON APPEAL]

CLAIM 8. [REJECTED & ON APPEAL]

CLAIM 9. [REJECTED & ON APPEAL]

CLAIM 10. [REJECTED & ON APPEAL]

CLAIM 11. [REJECTED AND NOT ON APPEAL]

CLAIM 12. [REJECTED AND NOT ON APPEAL]

CLAIM 13. [REJECTED & ON APPEAL]

CLAIM 14. [REJECTED & ON APPEAL]

D. STATUS OF AMENDMENTS

Applicant offered clarifying amendments –which were provided to the Examiner via email – during a telephonic conference after Final Rejection, but the Examiner made it clear that she would not allow any amendments. Therefore, there were no amendments post final rejection.

E. SUMMARY OF CLAIMED SUBJECT MATTER

There are five independent claims in the present disclosure: Claims 1, 10, 11, 12, and 14.

Claims 1 and 10 disclose a mouse pad with one or more perpendicular elements attached and anchored into it, said elements providing a barrier or bumper function to discourage the mouse from traveling off the mouse pad while the mouse is in use. In summary, the mouse can repeatedly bump against the barrier while in use, and is prevented from traveling off the mouse pad, and the user can, without looking, continue using the mouse uninterrupted (see, e.g., Page 1, paragraphs 0006-0007).

The essential anchoring points for the perpendicular bumper/barrier elements are obvious on the drawings, and they are particularly evident on Figs. 4 & 6, reference #14, Fig. 3, reference #13, and Fig. 12, reference #17. This anchoring is disclosed on Page 3, paragraph 48: the bumper/barrier member is pushed into and through the mouse pad. Further discussion of this functionality can be found on Page 3, paragraph 0059, and Page 4, paragraphs 0061, 0064, 0067, 0068, and 0070. This creates utility by providing resilience of the member to repeated striking by the mouse; the member will not become easily dislodged by a strike.

The use of a wider base for the bumper/barrier elements is evident particularly in Figs. 4-6, at reference #14. This is disclosed on page 3-4, paragraph 0060, and further on Page 4, paragraph

0067. This creates added utility by providing resilience of the member to repeated striking by the mouse.

The possible material for the bumper/barrier elements is disclosed on Page 2, paragraph 0047, to create the functionality by having the desired resiliency to impacts by a mouse.

Claim 14 discloses a related utility for an optical mouse: perpendicular elements provide a barrier to placing items other than a mouse on the mouse pad, thereby creating a clear, unencumbered, free-from-obstruction surface for an optical mouse, for movement around the pad. The particular utility is discussed on Page 3, paragraph 0049, but without specific reference to a particular drawing because all drawings are applicable.

F. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1.) Whether Claims 1, 8, 10, and 14 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Gillespie (# 6,125,032). The rejection of Claim 11 is not on appeal.

2.) Whether Claims 1, 6, and 7 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by non-patent literature of the “Information Fairway Mouse Pad,” to wit: an undated World Wide Web page. The rejection of Claim 12 is not on appeal.

3.) Whether Claims 1, 2, 4, 8, 10, and 14 are unpatentable under 35 U.S.C. § 103(a) as being obvious in light of Gillespie (# 6,125,032).

4.) Whether Claims 3, 5, and 9, are unpatentable under 35 U.S.C. § 103(a) as being obvious in light of Gillespie (# 6,125,032), in view of Depiero (# 5,952,070).

5.) Whether Claim 13 is unpatentable under 35 U.S.C. § 103(a) as being obvious in light of Gillespie (# 6,125,032), in view of Murphy (# 5,876,010).

G. ARGUMENT

1.) Claims 1, 8, 10, and 14 were not anticipated by Gillespie (# 6,125,032) because Gillespie does not teach several limitations in the present disclosure.

The §102 anticipation standard requires that a single reference teach each and every element of the application, expressly or inherently, to one of ordinary skill in the art.

a.) “Anchored in” limitation is not present in Gillespie.

Regarding the mounting of the perpendicular elements to the mouse pad, Gillespie does not teach an essential limitation in the present disclosure: i.e., anchoring the member into the mouse pad.

The Examiner admitted as such: Gillespie “fails to teach the member or members being anchored in the mouse pad.” (See page 3, last line, of Office Action dated March 9, 2005).

Contrast this with the present disclosure, Page 4, paragraph 0061 (“anchored in the flexible material”), Page 2, paragraph 0019 (“inserted into”), and Page 3, paragraph 0048, and Claims 1-9, and 13 of the present disclosure.

For this reason, the anticipation rejection using Gillespie cannot stand, and must be withdrawn, as it is an improper §102 rejection.

b.) Use-of-the-mouse limitation is not present in Gillespie, as it is explicitly in Claims 1, 8, and 10 of the present disclosure.

Gillespie is a three-dimensional, themed diorama meant to make a computer more visually appealing, with attachments to the computer screen, mouse pad, and wrist pad. The mouse pad attachment is in the form of a “mouse house” into which the mouse can be inserted and stored.

Gillespie teaches that the mouse pad have “an enclosure that is used for the storage of a mouse” (see '032, column 3, line 21). Even more specifically, Gillespie says that the “enclosure” or “mouse house” ('032, column 3, line 20) must have “an opening” for “inserting and removing” the mouse ('032, column 3, lines 23-24, and '032, claims 1 through 13).

The language of Gillespie makes it plain that the mouse is not to be used as a pointing device while it is in the enclosure. It is to be “stored” inside and cannot be used while in its “mouse house.”

The present disclosure forecloses the possibility of having an “enclosure” or “mouse house.” An “enclosure” is antithetical to the idea embodied in the present disclosure. Put another way, a bumper or “barrier” to “mouse movement” (see Claims 1, 8, and 10) for a mouse being used as a pointing device is not useful if one is storing a mouse in an enclosure. Logically, then, the lack of an “enclosure” is a limitation taught in the present disclosure. The limitations of the present disclosure are in logical contraposition to the requirements of Gillespie. For this reason, Gillespie does not anticipate an essential element of the present disclosure: the lack of an enclosure, or the use of the mouse as a pointing device.

c.) The “bumper” or “barrier” limitation is not present in Gillespie, as it is explicitly in Claims 1, 8, and 10 of the present disclosure.

Since Gillespie teaches an enclosure, Gillespie’s “mouse house” does not have the essential limitation of providing a bumper or “barrier to discourage mouse movement.” (see Claims 1, 8, and 10, and Page 3, paragraph 0047).

The present disclosure has a limitation of “providing a barrier to discourage mouse movement off” the edge of the mouse pad (see Claim 1), “while [the mouse pad is] in use” (see Page 1, paragraph 0016). The current disclosure makes clear that the perpendicular element is meant to be a bumper or barrier to the mouse traveling off the mouse pad *while it is in use* (see, e.g., Claim 1, Page 2, paragraph 0046, and Page 2, paragraph 0019). The mouse does not go into anything, but, rather, bumps off of the perpendicular element “while attempting to scroll the cursor around the screen with the mouse.” (Page 1, paragraph 0006).

First, in Gillespie, while the mouse is stopped or motionless while in the “mouse house,” this is because it is inserted in the “enclosure” for “storage,” and not by any properties of the “mouse house” itself. Equating the “mouse house” with a “barrier to discourage movement” is like equating an auto bridge guardrail with a car garage: parking a motionless car in a garage essentially keeps it from going off the road, just as does a guardrail, but certainly not in the same logical or functional sense.

Further, Gillespie’s “mouse house” is not anchored to the pad by any means that its outside shell could provide a barrier to the mouse. Anything not anchored in the pad will not serve as a barrier. Gillespie specifically teaches only that the “mouse house” is secured “to the surface” (see ’032, claim 3, column 6, line 32) and that the mounting is done “either frictionally or through the use of an adhesive tape or other securing method such as an adhesive glue.” (’032, column 3, lines 31-33).

In order to provide a barrier, the element must prevent mouse movement. Anchoring provides an improvement over surface attachment. In other words, the bumper/barrier limitation necessitates stronger attachment, such as anchoring, to overcome the problems with surface mounting.

Without “anchoring” the perpendicular members into the mouse pad, the members would peel or tear off when bumped by the mouse.

2.) Claims #1 and dependent Claims 6 and 7 were not anticipated by the pictured “Information Fairway Mouse Pad” because it does not teach several limitations in the present disclosure.

a.) “Anchored in” limitation is not present in the picture.

There is no indication from the “Information Fairway Mouse Pad” picture that the flagpole is “anchored” into the mouse pad. The manner of flagpole mounting cannot be discerned from the reference.

As noted in the preceding sections (particularly Section G.1.a. above) which are incorporated fully by reference herein, without this “anchored in” limitation, the reference does not teach a limitation present in this disclosure.

b.) The “golf hole” limitation of Claims 6 and 7 is not present in the “Information Fairway Mouse Pad” reference.

Claim 6 has the stated limitation that the upright member has a “golf hole.” Dependent Claim 7 likewise retains this limitation.

There is no indication in the picture that the reference has a “golf hole.” On the contrary, it appears in the picture that there is no facsimile of a hole at the base of the flagpole. For this reason, the “Information Fairway Mouse Pad” reference does not contain a limitation of the present disclosure.

c.) The “bumper” or “barrier” limitation is not present in the “Information Fairway Mouse Pad”.

As noted in the preceding sections (particularly above section G.1.c.) which are incorporated fully by reference herein, there is no indication from the reference that the flagpole could be used as a bumper or barrier to prevent the mouse from traveling off the pad while the mouse is in use. As noted above, secure attachment of a flagpole would be necessary in order to serve this purpose. There is no indication from the reference as to the means of attachment of the flagpole in the “Information Fairway Mouse Pad.”

For this reason, the “Information Fairway Mouse Pad” reference does not contain a limitation of the present disclosure.

3A.) Claims 1, 2, 4, 8, 10, and 14 are not obvious in light of Gillespie (# 6,125,032) because Gillespie teaches away from elements and limitations in the present disclosure.

The §103 obviousness standard requires that an examiner point out references, which were available to the inventor, which teach a suggestion to modify or combine the references in a way that the combination would have made the invention obvious to one of ordinary skill in the art. “[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988). The requirement that a showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

a.) Gillespie teaches away from secured mounting of the element onto the mouse pad.

Gillespie specifically teaches only that the “mouse house” is “secured to the working surface” (see ’032, claim 3; column 6, line 32) and that the mounting is done “either frictionally or

through the use of an adhesive tape or other securing method such as an adhesive glue.” (’032, column 3, lines 31-33). This is antithetical to the “anchoring” limitation in the present disclosure. No other mounting, other than light, superficial mounting, is contemplated by Gillespie.

There is no suggestion or teaching anywhere in Gillespie that a “mouse house” should be “anchored” to the mouse pad, such as by passing a peg through the pad material.

On the contrary, the pegs in Gillespie serve a completely different function. The reason for the use of “pegs” in Gillespie is to allow for interchangeable “mouse houses,” and not to securely fasten the “mouse house” to the mouse pad. (see ’032, column 3, lines 46-48). This is evidenced in the fact that the pegs themselves are surface mounted.

Since Gillespie is essentially a non-functional diorama, Gillespie’s mounting allows for a quick change of the diorama to quickly change the appearance of its “decorative array.” (see ’032, column 3, lines 46-47). Constructing the decorative array in such a manner as to achieve a quick change of the mouse house would allow the mouse house to become quickly dislodged if struck by a mouse. Easily interchanged mouse houses means they cannot be anchored. Not anchored means it would not provide a barrier or bumper function to mouse movement.

b.) Gillespie teaches away from the use of the mouse with respect to the element on the mouse pad.

Gillespie specifically teaches a mouse pad with “an enclosure that is used for the storage of a mouse” (see ’032, column 3, line 21). It further requires that its “enclosure” or “mouse house” (’032, column 3, line 20) must have “an opening” for “inserting and removing” the mouse (’032, column 3, lines 23-24, and claims 1 through 13). Having a “mouse house” that is used for mouse “storage” is antithetical to the idea of a mouse *being used (as a mouse)* continually, as in the present disclosure.

As noted in the previous sections, there is no suggestion anywhere in Gillespie that the mouse could continue to be used while in the “mouse house.” The only reasons for the existence of Gillespie’s “mouse house” are decoration and storage.

c.) Gillespie teaches away from the “bumper” or “barrier” function present in the instant disclosure.

The reasons for the existence of the Gillespie “mouse house” are noted above. There is no suggestion that the “mouse house” exists for any reasons other than “storage” and decoration.

The entire concept of the present enclosure is a bumper or barrier to prevent a mouse from moving off the mouse pad while the mouse is in use. This utility is other than merely decorative, unlike Gillespie's "decorative array."

First, it is illogical to say that storing a mouse inside an enclosure is equivalent to preventing it from moving off the mouse pad, as noted above.

Further, the Examiner is missing the point of the present disclosure, and Gillespie's patent, with the assertion that it would have been obvious "to have provided the peg on the bottom of the member or member [sic] while the mouse pad provided with [sic] the openings for receiving the pegs therein." (page 4, Office Action of March 9, 2005). The reason for the use of "pegs" in Gillespie is to allow for interchangeable "mouse houses," and not to securely fasten the "mouse house" to the mouse pad. (see '032, column 3, lines 46-48). If, as the Examiner argues, pegs were put on the bottom of the "mouse house," an essential feature of Gillespie's "mouse house" and its pegs would then be missing: the decorative "mouse house" would not have been capable of "exchanging [the] mouse house with other mouse houses with different themes...." (see '032, column 3, lines 46-47). The Examiner has, with hindsight, added a new feature to Gillespie which was not present: holes in the mouse pad.

As noted above, 'interchangeable' or "exchangeable" means that the mouse house would not be a barrier because it can become easily dislodged.

3B.) Claims 1, 2, 4, 8, 10, and 14 are not obvious in light of Gillespie (# 6,125,032) because Gillespie is non-analogous art.

According to the federal courts, “[t]wo criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved A reference is reasonably pertinent if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, . . . [i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.” *In re Clay*, 23 USPQ 2d 1058, 1060–61 (Fed. Cir. 1992). Further, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783–84 (Fed. Cir. 1992).

Gillespie is primarily classified under class 361/683, which is for ELECTRICITY:
ELECTRICAL SYSTEMS AND DEVICES/ HOUSING OR MOUNTING ASSEMBLIES
WITH DIVERSE ELECTRICAL COMPONENTS/ For electronic systems and devices /

Computer related support. This means that the USPTO considered Gillespie to have an electrical appliance housing application. That is, the Office felt that it was primarily a *storage* unit for a mouse, a field of endeavor entirely distinct from the present disclosure. It deals with a problem entirely distinct from the present disclosure.

Gillespie himself believed his invention to be a “decorative array” that was meant to make “a computer more enjoyable and fun” and to “stimulate [] interest in computing.” (see ’032, column 1, lines 16-22). Gillespie’s stated problem to be solved was how to “personalize” a computer since there were “deficiencies in computer system appearance.” (see ’032, column 1, lines 38-43). The “decorative array” description occurs in Gillespie’s every claim, making Gillespie somewhat more of a design patent than a utility patent, perhaps. The entire focus of Gillespie is on appearance. This focus on appearance makes Gillespie non-analogous to the present disclosure, which focuses on assisting the user in the usage of a mouse as a pointing device. Once again, a field of endeavor and problem solution entirely distinct from the present disclosure.

As such, there is no suggestion in Gillespie to modify the “mouse house” or its mounting to achieve the problems solved in the present disclosure. Gillespie used surface-mounted pegs on his mouse house so his decorative array could be quickly changed.

4.) Claims 3, 5, and 9 are not obvious over Gillespie (# 6,125,032) in light of Depiero (# 5,952,070) because the thinness of Depiero's sheet of Lexan would prevent anchoring of the element into the thin sheet.

Depiero discloses a mouse pad that is a thin, transparent sheet of plastic which can be stuck to a surface using an adhesive. Depiero teaches using a thin sheet of Lexan (.005 inches: see '070, column 2, lines 55-57) glued to a desk surface as a surface upon which to use a mouse. While Gillespie's mouse house might be glued to the top of a Lexan sheet, and serve the decorative purposes that is Gillespie's disclosure, one could not anchor an element into a thin Lexan sheet. It is therefore not obvious that one could anchor Gillespie's mouse house into Depiero's .005-inch plastic sheet. It appears that Depiero might provide the basis for a Gillespie mouse house, but irrespective of this, it does not follow that this combination could teach the anchoring of an element *into* the plastic sheet.

5.) Claim 13 is not obvious over Gillespie (# 6,125,032) in light of Murphy (# 5,876,010) because the combination of Gillespie's attachment to Murphy would prevent the use of Murphy's pad of paper.


Murphy is a mouse pad formed by a pad of paper with multiple sheets that can be written on and sheets torn off. Murphy thus disclosed a mouse pad consisting of a pad of paper "with a plurality

of sheets of paper.” (see ’010, all claims.) These sheets are secured along the edges, and can be torn off to offer a new writing surface. (see ’010, column 1, lines 53-56).

The combination of Murphy with a connected structural element on top of Murphy’s pad of paper would prevent an essential function of Murphy: an element would prevent a user from tearing off sheets of paper. Further, were one to anchor an element into Murphy’s pad of paper, the result would be even worse: Murphy’s functionality would be prevented and his invention would be useless. As such, the combination would not be performed by any one and the references teach away from a combination.

For the above reasons, the Applicant asks that the Board reverse the rejections made by the Examiner and allow the claims in the present disclosure.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'E. A. Skoch', with a stylized, cursive script.

Edwin A. Skoch

Attorney, Reg. No. 50,483, Representing David Mabbutt

H. CLAIMS APPENDIX

Current Listing of Claims:

CLAIM 1. A mouse pad, comprising a mouse pad with one or more connectedly attached members at or near the edge of said mouse pad, said member or members anchored in and protruding above the surface of said mouse pad in a roughly perpendicular fashion and providing a barrier to discourage mouse movement off that edge of said mouse pad where said member or members is located.

CLAIM 2. A mouse pad, as in claim 1, wherein said member or members is in the shape of a hockey goal and said mouse pad has the appearance of a full or partial hockey rink.

CLAIM 3. A mouse pad, as in claim 2, further comprising graphics or text, used for promotional purposes.

CLAIM 4. A mouse pad, as in claim 1, wherein said member or members is in the shape of a basketball post, backboard, and hoop and said mouse pad has the appearance of a full or partial basketball court.

CLAIM 5. A mouse pad, as in claim 4, further comprising graphics or text used for promotional purposes.

CLAIM 6. A mouse pad, as in claim 1, wherein said member or members is in the shape of a golf hole, post, and flag and said mouse pad has the appearance of a full or partial golf green.

CLAIM 7. A mouse pad, as in claim 6, further comprising graphics or text, used for promotional purposes.

CLAIM 8. A mouse pad, as in claim 1, wherein said member is in the shape of a football goalpost and said mouse pad has the appearance of a full or partial football field.

CLAIM 9. A mouse pad, as in claim 8, further comprising graphics or text, used for promotional purposes.

CLAIM 10. A mouse pad, comprising a mouse pad with one or more connectedly attached and raised members near the periphery of said mouse pad, said member or members anchored into said mouse pad and providing a barrier to mouse movement off that mouse pad edge where said member or members are anchored.

CLAIM 11. [NOT ON APPEAL].

CLAIM 12. [NOT ON APPEAL].

CLAIM 13. A mouse pad, as in claim 1, wherein said mouse pad further comprises a porous surface that can be written on.

CLAIM 14. A mouse pad that can be used with an optical mouse, comprising a mouse pad with one or more connectedly attached members at or near the edge of said mouse pad, said member or members anchored in and protruding above the surface of said mouse pad in a roughly perpendicular fashion and providing a barrier to discourage the user from placing items on or over said mouse pad.

I. EVIDENCE APPENDIX

None.

Appl. No. 10/707,437
Inventor: Mabbutt, David L.
Improved Mouse Pad
Second Amended Patent Appeal Brief

I. RELATED PROCEEDING APPENDIX

None.

Certificate of Mailing

I hereby certify that the attached:

AMENDED APPEALS BRIEF with Appendix of Claims (24 pages)

for Application 10/707,437 filed 14.12.03, Inventor: David L. Mabbutt

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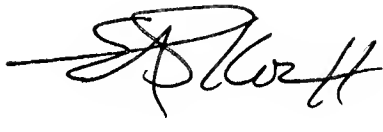
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on December 27, 2006.

A handwritten signature in black ink, appearing to read "E. Skoch", written over a horizontal line.

(Signed)

Edwin A. Skoch, Reg. No. 50,483, Cust. No. 33310